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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,207	02/11/2004	Michael J. Hubbard	OMNO-0003-1	9961

7590 09/30/2005

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,207	Applicant(s) HUBBARD, MICHAEL J.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3 IDS's</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1771

1. The Examiner notes that applicant's amendments to the Title and Abstract appear to be in each instance vague, indefinite, and confusing. More particularly, the Examiner does not understand what is a "Pre-applied membrane" and how this apparent process limitation distinguishes the invention. Clarification is requested.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim 5 there is no antecedent basis for "said first adhesive", and in claims 11 and 12 the phrase "by using" is vague and indefinite. Also, in each of these claims "coated on" is believed to be unduly vague and indefinite with respect to the location of the first and second adhesive; also in claim 11, line 3, after "providing" insert --a--.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1,2,4-7,11 and 14-17 are rejected under 35 U.S.C. 102(a) as being anticipated by US 2003/0219564 to Hubbard, the applicant of the present application. Note particularly paragraph 0016 and claims 1-3 and 6, as well as the Abstract and Figures, paragraphs 0002, 0004, 0005, 0009, 0015, 0018-0020, 0022-0024, and claim 10. Note that although the majority of the specification is not directed to embodiments where a "fabric layer" or "fabric material" is located adjacent the thermoplastic

Art Unit: 1771

membrane on one outer surface and an adhesive covering at least a portion of the lower surface of the fabric layer, the presence of a "reinforcing mesh(s) or scrim(s) located between membrane 12 and hot melt psa layer 14 is clearly taught, and such reinforcing meshes and scrims are clearly seen to each be a "fabric layer".

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3,8-10, 12, 13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbard. The reference is again relied upon substantially as set forth above, with such parameters as the geometry of the fabric layer, the presence of a non woven fabric layer, conventional additives such as UV absorbers and screeners, and the various nominal process steps found in claim 12 are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Venable '785 or '812, each taken individually, or in view of either Hubbard or WO98/56866. The primary references each disclose (note particularly Venable'785, the Abstract, Col 1, lines 9-15, lines 40-53, Col 2, lines 26-43, Col 3, lines 4-15; Venable '812, Col 1, lines 7-24, line 47-Col 2, line 17) substantial anticipations of at least the broad article and method claims except that the '785 patent utilizes a strip of double sided adhesive tape for the outer adhesive layer covering the fabric, while the '812

Art Unit: 1771

patent has the fabric layer, i.e. matting, at least partially embedded in the adhesive (Col 1, lines 19-20) before becoming solidified. However, these limitations are believed to be, if not anticipatory elements of applicant's claims, teachings that are sufficient to put the claimed embodiments within the ordinary skill of the art. Alternatively, the secondary references disclose (note, in addition to the previously relied upon disclosure of Hubbard, paragraphs 0019 and particularly 0020, the latter which teaches applicant's preferred adhesive; WO' 866, page 2, lines 22-25, page 3, lines 4-8, and Fig 2 and dry psa layer 12) the possibly missing element of a suitable solid, i.e. hot melt psa layer on the lower surface of the claimed laminate which is suitable for adhering the claimed covering material to a desired substrate, such as a suitable building structure. The references are believed to be clearly combinable, each taken from the roofing art which is clearly an example of a covering material, with the motivation being ease in application and use, together with the absence of harmful solvents and the like. Other parameters which are not either expressly or inherently disclosed are again believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.